

REMARKS

Petition for Extension of Time Under 37 CFR 1.136(a)

It is hereby requested that the term to respond to the Examiner's Action of August 21, 2007 be extended three months, from November 21, 2007 to February 21, 2008.

Authorization to charge a Credit Card is given to cover the extension fee. The Commissioner is hereby authorized to charge any additional fees associated with this communication to Deposit Account No. 19-5425.

In the Office Action, the Examiner indicated that claims 1 through 12 are pending in the application and the Examiner rejected all of the claims.

The §112 Rejection

On page 2 of the Office Action, the Examiner has rejected claim 12 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 1 has been amended to explicitly recite that the two directory hierarchies are incompatible, emphasizing the advantage resulting from the invention. It has also been amended to refer to the file system as "a" rather than "the" since there was no antecedent basis for "the file system". Claim 12 has been amended to explicitly provide antecedent basis for the term "the first", which was objected to by the Examiner in item 3 of the Office Action.

Rejections under 35 U.S.C. §§102 and 103

On page 3 of the Office Action, the Examiner rejected claims 1, 4 and 9 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,868,480 to Nakajima.

On page 6 of the Office Action, the Examiner rejected claims 2, 3, 5 and 10 under 35 U.S.C. §103(a) as being unpatentable over Nakajima and further in view of U.S. Patent No. 6,985,912 to Mullins et al. On page 10 of the Office Action, the Examiner has rejected claims 6, 7, 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Nakajima and further in view of U.S. Patent No. 6,836,834 to Schulze et al. On page 14 of the Office Action, the Examiner has rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over Nakajima and further in view of Mullins et al. and Schulze et al.

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (*Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) M.P.E.P. §2131.

In item 4, on page 3 of the Office Action, the Examiner has rejected claims 1, 4, and 9 under 35 U.S.C. §102 as being anticipated by Nakajima. Applicant disagrees that all features of the claim as originally filed are disclosed in Nakajima, and also notes that the newly added clause of claim 1 is not found in Nakajima, as acknowledged by the Examiner on page 14 of the Office Action.

As a general point, it is noted that the problem addressed by Nakajima is quite different than the problem addressed by the present invention. Nakajima is concerned with the protection of data on a removable medium (see column 1, lines 9-26), while the present invention concerns

enabling access to data on an *incompatible* removable medium (see title, and page 1, lines 8-10). Nakajima is therefore attempting to obscure the data on the removable medium, and this is achieved by providing an embedded application and a processor on the medium itself, such that the protected data can be internally processed before being released to a host computing device wishing to access the data (column 2, lines 14-24). Not only is the manner of this internal processing intentionally shielded from the host computer (column 8, lines 6-14), but also the very fact that the internal processing is occurring is preferably hidden from the host computer, such that the host computer need not know that the protection is being enforced (column 5, lines 42-49 and column 8, lines 22-25). All of the modifications are preferably made to the removable medium itself.

In contrast, the present invention concerns a novel technique for facilitating an application on a host computer, running on a particular operating system, to access files stored on a removable medium, where the removable medium and the operating system on the host computer use different and incompatible directory hierarchies (page 6, lines 3-15). No modification is intended to be made to the removable medium – in fact a key advantage of the invention is that it ensures that pre-existing types of removable media may be accessed by a host computer that uses a preexisting and different directory hierarchy. The modifications required to enable this access are made within the host computer (claim 12).

Turning now to the specific terms of the independent claim 1, Nakajima does not teach or suggest the following aspects of claim 1:

- that the application runs on an operating system with a first directory hierarchy. (No mention is made of an operating system on the host computing device or the directory hierarchy that it uses (column 4, lines 28-65 and column 5, lines 9-63).)

- that the removable storage medium uses a second directory hierarchy that is incompatible with the first. (As mentioned above, the examiner has acknowledged that this aspect of the invention is not disclosed in Nakajima.)

- that the application sends a file request with a path that conforms to the first directory hierarchy. (While it could be argued that this concept is implicit in Nakajima, there is no reason to suppose that the host computer would not make the request directly compatible with the directory hierarchy of the removable medium.)

- that the file system starts a search for the file from a location within the second directory hierarchy that is different from the start location defined by the file request. Applicant acknowledges that Nakajima refers to a file system on the host computer (220 in Figure 2); however, there is no discussion in Nakajima about how files are accessed within directories. As pointed out by the Examiner, Nakajima states that the file system maps an access request to pseudo-locations of the removable medium (column 6, line 67 to column 7, line 5) and forwards the request to the device driver of the removable medium, which then accesses the required content from the removable medium. There is no mention of directory hierarchies in this discussion, nor of start locations or paths. Nakajima makes very little comment on how the content on the removable medium is actually accessed, other than to say that the content generation on the removable medium is shielded from the host computer. There is certainly no suggestion that the file system on the host computer chooses a start location that is different from the one in the file request.

For these reasons, independent claim 1 (and all claims depending therefrom), is novel over Nakajima. Corresponding arguments apply to the independent device claim 12 which is of a similar scope. Moreover, Nakajima is directed to solving a completely different problem to the

one addressed by the present application (as explained above), and so provides the skilled person with no motivation or suggestions for implementing the invention claimed in this application. Thus, claims 1 and 12 (and all claims depending therefrom) patentably define over Nakajima and are in condition for allowance.

The Examiner Has Not Established a Prima Facie Case of Obviousness

As set forth in the MPEP:

To support a rejection under 35 U.S.C. §103, a reason, suggestion, or motivation to lead an inventor to combine two or more references must be found. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 37 U.S.P.Q.2d 1627, 1629 (Fed.Cir. 1996). The Examiner has not met his burden in establishing a reason, suggestion, or motivation for combining the cited references.

The secondary references cited by the Examiner do not teach or suggest the elements identified above as being missing from Nakajima. Regarding the Examiner's comments about Schulze, nothing in Schulze teaches or suggests an application running on a first operating system with a first directory hierarchy that access files stored on a removable storage medium that uses a second directory hierarchy incompatible with the first. Schulze mentions the use of first and second storage allocation tables, but these are not analogous to an application running on a first operating system with a first directory hierarchy that access files stored on a removable storage medium that uses a second directory hierarchy incompatible with the first.

In view of the above, it is submitted that the present claims, as amended, patentably define over the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims under 35 USC §§102 and 103.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to applicant's Deposit Account No. 19-5425.

Respectfully submitted

February 21, 2008
Date

/Mark D. Simpson/
Mark D. Simpson, Esquire
Registration No. 32,942

SYNNESTVEDT & LECHNER LLP
112 Nassau Street
Princeton, NJ 08542-0592
Telephone: 609 924 3773
Facsimile: 609 924 1811
MSimpson@synnlech.com